

**REMARKS**

As is well settled, all that is required to comply with 35 U.S.C. §112, second paragraph, is that the metes and bounds of what is claimed be determinable with a reasonable degree of precision and particularity. *Ex parte Wu*, 10 USPQ2d 2031, 2033 (BPAI 1989). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope when it is read in the light of the specification. *In re Warmerdam*, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Applicant respectfully assert that the claims of the amended meet this standard.

It is respectfully submitted that the scope of claims 2-24 and 26-31 are readily ascertainable to one skilled in the art when the claims are read in the light of the description portion of the specification and the state of the art as of the filing date of the present application.

Applicants respectfully asserts that claims 29, 30 and 31 referring to a “fixed DC output” contains subject matter which is reasonably conveyed to one of skill in the relevant art. In the specification as originally filed, reference is made to the DC voltage being “24 volt DC (VDC)”. The apparatus uses “regulated direct current (DC) power from the power supply 16”. The regulated “DC power” is “fixed” as a result of the regulation. Support for this assertion is found on page 3 of the specification as originally filed.

With the foregoing in mind, Applicant respectfully assert that the continued rejection of these claims under 35 U.S.C. §112 would be improper and should be withdrawn.

**Rejections Under 35 U.S.C. §102 (b) and 35 U.S.C. §103 (a)**

All of the pending claims have been rejected under 35 U.S.C. §102 as being anticipated by Kimura or under 35 U.S.C. §103 (a) as being obvious primarily based on Kimura in combination with one or more additional references.

With regard to the rejection under 35 U.S.C. §102, it is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Manufacture Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a particular prior art reference and arranged as in the claims. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH*, see *American Hoist and Derrick Company*, 221 USPQ481, 485 (Fed. Cir. 1984). Furthermore, in a rejection under 35 U.S.C. §102 (b) there must be no difference between what is claimed and what is disclosed in the

applied reference. *In re Kalm*, 154 USPQ10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001,1010 (Fed. Cir. 1991).

Further, with regard to the rejections under 35 U.S.C. §103 (a), it is respectfully submitted that applicants claims are patentable, as the Examiner has failed to establish a *prima facie* case of obviousness. According to section 706.02 (j) of the MPEP the Examiner must meet three basic criteria to establish a *prima facie* case of obviousness:

- (1) first, there must be some reasonable suggestion or motivation in the prior art to modify the reference or to combine the reference teachings;
- (2) second, there must be reasonable expectation of success in obtaining the claimed invention based upon the references relied upon the Examiner; and
- (3) third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

MPEP Section 706.02(j) further requires that the teaching or suggestion to make the modification or reference combination and the expectation of success, must be found in the prior art, and may not be based upon the applicants disclosure.

The Examiner's rejections are dependent on the Kimura reference. Applicant respectfully asserts that the Kimura reference is not applicable to support the rejection under 35 U.S.C. §102 (b) and is not suitable to support the rejection in combination with other references under 35 U.S.C. §103 (a).

The Examiner appears to not appreciate the subject matter of Kimura in contrast to the present invention. As shown and described with regard to Figure 2 of Kimura, the value of the capacitor 39 and the resistor 36 do not change. If the AC source changes (e.g., from domestic to foreign voltage as asserted in the present application) the voltage supply to the capacitor will change. As such, capacitor 39 is not a regulated or fixed DC voltage output of substantially predetermined value regardless of whether the input is coupled to the domestic AC voltage or the foreign AC voltage as set forth in the present claims.

In other words, as shown in Kimura, if AC source 35 changes from domestic to foreign, the DC voltage output provided by capacitor 39 will change. The DC voltage output provided by capacitor 39 will not be regulated or fixed and does not provide an output of substantially a predetermined value regardless of whether the input is coupled to the domestic AC voltage or the foreign AC voltage.

These distinctions show that Kimura fails to show each and every element recited in the independent claims 29-31 and as a result the claims depending therefrom. As described above, there is a difference between what is claimed and what is disclosed in the applied reference, thereby causing the Kimura reference to fail as a reference to support the rejection under 35 U.S.C. §102.

Further, the Kimura reference fails to provide the foundation for the rejections under 35 U.S.C. §103 (a) since it does not support a *prima facie* case of obviousness. The Kimura reference does not meet the basic criteria to establish a *prima facie* case of obviousness. First, there is no reasonable suggestion or motivation in Kimura to modify it or combine it. It teaches a system that is different from the claimed invention and actually teaches away from the invention due to these differences. Second, there is no indication in Kimura of a reasonable expectation of success since it fails to appreciate the problem and solution of the claimed invention, absent the influence the teachings of the present application. Third, Kimura cannot teach or suggest all of the claimed limitations since it fails to teach the basic limitations for which it is asserted by the Examiner. It would appear that any attempt to apply Kimura to the present application necessarily relies on the influence of Applicant's disclosure to provide the understanding, teaching, or motivation of the problems and solutions which are not found in Kimura.


In view of the above comments it is suggested that claims 2-24 and 26-31 are in condition for allowance and such action is, respectfully, requested.

If there is any issue remaining to be resolved, the Examiner is invited to telephone the undersigned so that resolution can be promptly effected.

It is requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response with the fee for such extensions and shortages in other fees, being charged, or any overpayment in fees being credited, to the Account of Barnes & Thornburg, Deposit Account No. 12-0913 (27726-99611).

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in black ink, appearing to read "Grant H. Peters", written over a horizontal line.

Grant H. Peters

Reg. No. 35,977

Tel. No. (312) 214-8332

Dated: 22 September 2008